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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/898,844

07/03/2001

Edward T. Hessel

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1464

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06/17/2004

EXAMINER

GRIPPIN, WALTER DEAN

ART UNIT

PAPER NUMBER

1764

DATE MAILED: 06/17/2004

Law Offices
Mark Farber
Suite 400
6 Landmark Square
Stamford, CT 06901

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/898,844

Applicant(s)

HESSELL ET AL.

Examiner

Walter D. Griffin

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/3/01
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Oath/Declaration

The signed oath/declaration appears to be missing from the application file. The examiner requests that applicant resubmit the declaration/oath.

Specification

The disclosure is objected to because of the following informalities: In line 23 of page 3, the word “triphenylene” is misspelled.

Appropriate correction is required.

Claim Objections

Claim 2 is objected to because of the following informalities: The word “chrysene” is misspelled.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 14 is indefinite because the expression "the additive package" lacks proper antecedent basis in claim 1. It appears as if claim 14 should depend on either claim 4 or claim 5.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 5, and 8-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Moore et al. (US 2,816,868).

The Moore reference discloses a composition comprising a mineral base oil (60 to 95%) and a fused aromatic compound (5 to 40%). The fused aromatic compounds may contain alkyl radicals attached to the rings. Example I discloses that alkyl phenanthrenes and chrysenes are added to the base oil. The composition may also contain an additive (1 to 2%) such as viscosity index improvers. See column 1, lines 15-47 and column 4, lines 63-67.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3, 6, 7, and 15-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore et al. (US 2,816,868).

The Moore reference discloses a composition comprising a mineral base oil (60 to 95%) and a fused aromatic compound (5 to 40%). The fused aromatic compounds may contain alkyl radicals attached to the rings. Example I discloses that alkyl phenanthrenes and chrysenes are added to the base oil. The composition may also contain an additive (1 to 2%) such as viscosity index improvers. See column 1, lines 15-47 and column 4, lines 63-67.

The Moore reference does not disclose the specific aromatic compound of claims 3 and 28, does not disclose the use of Group II and/or Group III base oils, and does not the alkyl chain lengths as in claims 15-27, 29, and 30.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of Moore by utilizing an alkylated

naphthalene as the fused aromatic compound because these compounds fall within the general class of effective compounds and therefore their use in the composition would be expected to result in a composition having the desired characteristics.

It also would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of Moore by utilizing a Group II and/or Group III base oil in the composition because such base oils, as evidenced by applicant's own specification, are comprises predominantly of saturates as are the base oils disclosed by Moore. Therefore, one would expect to produce an effective lubricating oil by substituting a Group II and/or Group III base oil for the base oil of Moore since the Group II and III base oils are chemically similar to the base oils disclosed by Moore.

It also would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of Moore by utilizing alkyl groups having the chain lengths as claimed because Moore does not limit the chain length of the attached alkyl groups. Therefore, one would expect any alkylated fused aromatic compound to perform equivalently to any other in the composition.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art not relied upon discloses mineral oil compositions.

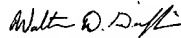
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter D. Griffin whose telephone number is (571) 272-1447.

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The examiner can normally be reached on Monday-Friday 6:30 to 4:00 with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Walter D. Griffin
Primary Examiner
Art Unit 1764

WG
June 15, 2004